

REMARKS

In response to the Final Office Action mailed February 23, 2007, Applicants respectfully request reconsideration. To further the prosecution of this application, amendments have been made in the claims, and each of the rejections set forth in the Office Action has been carefully considered and is addressed below. The claims as presented are believed to be in condition for allowance.

Claims 1-6, 8-10 and 18-39 were previously pending in this application. Claims 1, 9, 10 and 18 are amended herein. No claims have been added or canceled. As a result, claims 1-6, 8-10 and 18-39 remain pending for examination, with claims 1, 9, 10 and 18 being independent. No new matter has been added.

Telephone Conference with Examiner

Applicants' representatives thank Examiner Ly for the courtesies extended in granting and conducting a telephone interview on April 30, 2007. The substance of the interview is summarized herein.

During the interview, Applicants' representatives provided an overview of one embodiment of the invention, which relates to an apparatus comprising, *inter alia*, a control unit which detects a reproduction status of a plurality of content data items (e.g., whether a music, video or other content data item has been played, for how long, how many times within a given period, etc.) and selects a recommendation content data item based on that reproduction status. A communication unit transmits a list showing the selected recommendation content data item to another apparatus. Applicants' representatives explained that, in one implementation wherein the apparatus comprises a media (e.g., music) player, selection of a media file based on its reproduction status may allow, for example, the player to automatically assemble a list of recommended media files as a user employs the device in the normal course, without requiring any overt action by the user. The list of recommended media files may be transmitted to another media player, such that users of different media players may easily share lists of their favorite songs.

The rejection of claims 1-10 and 18-39 under 35 U.S.C. §103(a) as purportedly being unpatentable over U.S. Patent Publication No. 2001/0006771 to Kajiyama et al. ("Kajiyama") in

view of U.S. Patent Publication No. 2002/0131594 to Hori et al. ("Hori") was discussed.

Applicants' representatives explained that neither Kajiyama nor Hori discloses or suggests detecting a reproduction status of a plurality of content data items *when each content data item is reproduced*, or selecting a *recommendation* content data item depending on a reproduction status. For example, Kajiyama discloses a method for synchronizing the playback of information stored in different storage areas based on pre-recorded reproduction management information, and says nothing at all relating to selecting a recommendation content data item or detecting a reproduction status when a content data item is reproduced.

The Examiner agreed with this assessment, and asked that a written response be filed for his consideration.

Priority Claim

The Office Action indicates that a translation of the Japanese application to which the present application claims priority should be submitted in order to obtain the benefit of foreign priority under 35 U.S.C. §119. A certified copy of Japanese application JP-2002-212661, to which the present application claims foreign priority, was submitted on July 22, 2003, concurrently with the filing of the present application. As a result, Applicants believe no translation is required. If the Examiner disagrees, he is respectfully requested to call the undersigned at the number listed below to discuss the matter further.

Objections To the Drawings

The Office Action objects to the drawings under 37 C.F.R. §1.84 (p)(4) for purportedly using the reference characters "11-1" and "11-2" to designate different features depicted in FIGS. 1 and 12. Applicants respectfully traverse this objection.

The use of reference characters "11-1" and "11-2" is consistent in FIGS. 1 and 12. Specifically, Applicants' specification states that the flowchart depicted in FIG. 12 is a process performed by the portable terminals 11-1 and 11-2 (p.28, lines 1-3). Portable terminals 11-1 and 11-2 are also shown in FIG. 1 (p.13, lines 3-6). Because reference characters 11-1 and 11-2 are

used consistently in FIGS. 1 and 12, Applicants respectfully request that the objection to the drawings under 37 C.F.R. §1.84 be withdrawn.

The Office Action also contends that FIGs. 1, 4, 9, 13, 18, 19 and 20 are missing labels for each of the boxes shown therein. Applicants respectfully traverse this objection.

The Office Action cites no authority in support of its contention that each box in each of these figures must be accompanied by a label, and Applicants believe no such requirement exists. If the objection is to be maintained, Applicants respectfully request that the Examiner cite specific authority requiring Applicants to label each box in all of the figures.

The Office Action also objects to the drawings under 37 C.F.R. §1.83(a) for purportedly failing to depict each limitation of claims 9, 10 and 18. Applicants respectfully traverse this objection as well.

Each feature specified in independent claims 9, 10 and 18 are shown in the drawings. For example, the method of claim 9 comprises steps of reproducing a plurality of content data items (shown, e.g., as steps S2, S7 and S8 in FIG. 8), detecting a reproduction status (shown, e.g., as steps S3 and S4 in FIG. 8), selecting a content data item (shown, e.g., as step S6 in FIG. 8), and transmitting a list (shown, e.g., as step S47 in FIG. 12). Claim 10 recites at least one computer-readable medium having instructions encoded thereon which, when executed, perform a method substantially similar to the method of claim 9, such that the features of claim 10 are also shown in the drawings. Claim 18 recites a data processing system having first and second data processing apparatus (shown, e.g., as 11-1 and 11-2 in FIG. 9), each of which comprises a reproducing unit (e.g., reproduction unit 77, shown in FIG. 3), a control unit (e.g., control unit 71, shown in FIG. 3) and a communication unit (e.g., communication unit 76, shown in FIG. 3). As a result, the drawings show each feature of the invention specified in independent claims 9, 10 and 18.

In view of the foregoing, Applicants respectfully request that the objections to the drawings be withdrawn.

Rejections Under 35 U.S.C. §112

Claim 18 is rejected under 35 U.S.C. §112, first paragraph, for purportedly failing to comply with the written description requirement. Specifically, the Office Action contends that limitations requiring a “first reproducing unit” and “second reproducing unit” lack support in the specification or drawings.

These limitations are supported by the specification and drawings. For example, FIG. 1 depicts portable terminals 11-1 through 11-6 (see e.g., Applicants’ specification at p.12, lines 10-12). Functions implemented by each of portable terminals 11-1 through 11-6 are shown in the functional block diagram of FIG. 3 (described at p.15, lines 10-12). In particular, each portable terminal includes a “reproduction unit” that reproduces tunes stored in a storage unit (p.16, lines 1-3). Because each portable terminal includes a reproduction unit, each may be considered a “reproducing unit” as recited by claim 18. FIG. 1 depicts multiple reproducing units (i.e., portable terminals 11-1 through 11-6), such that one of the reproducing units may be considered a “first reproducing unit” and another may be considered a “second reproducing unit.”

As such, claim 18 complies with the written description requirement. Accordingly, the rejection of claim 18 under 35 U.S.C. §112, first paragraph, should be withdrawn.

Rejections Under 35 U.S.C. § 101

Claims 1-6, 8-10 and 18-39 are rejected under 35 U.S.C. §101. Applicants respectfully traverse these rejections for the reasons discussed below.

A. Claims rejected for purportedly failing to satisfy the utility requirement

Claims 1-6, 8-10 and 18-39 are rejected under 35 U.S.C. §101 for purportedly failing to satisfy the utility requirement. Specifically, the Office Action contends that these claims are lacking of “real world useful result” and “are missing the steps or processes producing any useful result to the invention.” Applicants respectfully traverse this rejection, as claims 1-6, 8-10 and 18-39 satisfy the utility requirement.

MPEP §2107(II)(B)(I) provides that “[i]f the Applicant has asserted that the claimed invention is useful for any particular practical purpose (i.e., that it has a “specific and substantial utility”), and the assertion would be considered credible by a person of ordinary skill in the art, do not impose a rejection based on lack of utility.”

The invention recited by each of claims 1-6, 8-10 and 18-39 has a specific utility. A specific utility is one that “is specific to the subject matter claimed and can “provide a well-defined and particular benefit to the public.” *See* M.P.E.P. §2107(.01)(I)(A), pp. 2100-2022 of original 8th Ed., Rev. 5, August 2006. Each of claims 1-6, 8-10 and 18-39 recites subject matter that is specific to the claimed invention and which provides a well-defined benefit to the public. For example, claim 1 recites a data processing apparatus comprising a control unit configured to select a recommendation content data item from said plurality of content data items depending on a reproduction status of the recommendation content data item, and a communication unit configured to transmit to another data processing apparatus a list which shows the selected recommendation content data item. As a result, a user of the other data processing apparatus receives a list that includes a recommendation of a content data item, such that the user may, as an example, learn about new content data items that may be interesting to them.

“[T]o satisfy the ‘substantial’ utility requirement, an Applicant must show that the claimed invention has a significant and presently available benefit to the public.” *See* M.P.E.P. §2107(.01)(I)(B), pp. 2100-2023 of original 8th Ed., Rev. 5, August 2006. A reasonable use which the Applicant has identified for the invention that can be viewed as providing a public benefit should be accepted as sufficient, at least with regard to defining “substantial utility.” *See* M.P.E.P. §2107(.01)(I)(B), pp. 2100-2023-2100-2024 of original 8th Ed., Rev. 5, August 2006.

The invention recited by each of claims 1-6, 8-10 and 18-39 provides a significant and presently available benefit to the public. For example, claim 1 produces a result of transmitting a list showing a recommendation content data item which is selected from a plurality of content data items depending on its reproduction status. This result is both significant, as discussed above, and presently available, as it may be transmitted upon the selection of a recommendation content data item.

In view of the foregoing, Applicants respectfully submit that claims 1-6, 8-10 and 18-39 satisfy the utility requirement, such that the rejection of these claims under 35 U.S.C. §101 for purportedly failing to satisfy the utility requirement should be withdrawn.

B. Claims rejected for purportedly reciting non-statutory subject matter

Claims 10 and 31-39 are rejected under 35 U.S.C. §101 for purportedly reciting non-statutory software *per se*. Applicants respectfully traverse this rejection as well, as claims 10 and 31-39 do not recite software *per se*.

Claim 10 recites at least one computer-readable medium having instructions encoded thereon which, when executed, perform a process. During the interview, the Examiner stated that to make claim 10 statutory under §101, the words “when executed” should be removed from the claim. The Examiner pointed to no specific authority for this contention, and Applicants respectfully submit that no such authority exists. If this rejection is to be maintained, Applicants respectfully request that the Examiner cite such authority.

The Office Action contends that claim 10 is directed to non-statutory software *per se*, and also includes a quotation of a long passage from M.P.E.P. §2106.01, which discusses the patentability of computer-related subject matter. This passage states that “functional descriptive material” includes computer programs which impart functionality when employed as a computer component. By contrast, “non-functional descriptive material” includes things like music, literary works, and arrangements of data. While non-functional descriptive material can not be made statutory by recording it on a computer-readable medium, functional descriptive material can. Specifically, M.P.E.P. §2106.01 states, “[w]hen functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.” As the instructions recorded on the at least one computer-readable medium of claim 10, when executed, perform a process, the instructions are functional, and the at least one computer-readable medium on which they are encoded is statutory.

The Office Action states that the computer-readable medium of claim 10 includes a “communication unit conveying signals as [a] transmission device,” which it contends is non-statutory subject matter. This is not the case, as claim 10 does not recite a communication unit conveying signals, and even if this statement were accurate, it would simply not be relevant to the patentability of claim 10 under §101. Specifically, the fact that the computer-readable medium of claim 10 is encoded with instructions which, when executed, perform a method comprising transmitting a list has nothing to do with whether the computer-readable medium itself (i.e., the subject matter recited by claim 10) is statutory under §101. In fact, the performance of a function (i.e., the transmitting of a list) shows that what is encoded on the computer-readable medium is functional (rather than non-functional) descriptive material, which M.P.E.P. §2106.01 explicitly states is statutory when recorded on a computer-readable medium.

For at least the foregoing reasons, the rejection of claims 10 and 31-39 under 35 U.S.C. §101 for purportedly reciting non-statutory software *per se* should be withdrawn.

Claim Rejections Under 35 U.S.C. §103

Claims 1-6, 8-10 and 18-39 are rejected under 35 U.S.C. §103(a) as purportedly being obvious over Kajiyama in view of Hori. As amended herein, the claims patentable distinguish over the asserted combination.

A. Claim 1

As amended herein, claim 1 recites a data processing apparatus. The apparatus comprises a reproducing unit configured to reproduce a plurality of content data items; a control unit to configure to detect a reproduction status of each content data item when said each content data item is reproduced by said reproducing unit, and to select a recommendation content data item from said plurality of content data items depending on a reproduction status of said recommendation content data item; and a communication unit configured to transmit, to another data processing apparatus, a list which shows said selected recommendation content data item.

The Office Action contends that Kajiyama discloses all of the limitations of claim 1 except for a communication unit configured to transmit a list which shows a selected recommendation content data item to another data processing apparatus. The Office Action contends that Hori discloses this limitation, and that it would have been obvious to one skilled in the art at the time of the invention to modify the system of Kajiyama according to the teachings of Hori “for the purpose of reproducing data obtained by a data distribution system.”

Without acceding to the propriety of the asserted combination, Applicants respectfully submit that claim 1 patentably distinguishes over the prior art of record, as no combination of Kajiyama and Hori satisfies the limitations of amended claim 1.

Kajiyama, which the Office Action cites as purportedly meeting all of the limitations of claim 1 except for a communication unit configured to transmit to another data processing apparatus, fails to disclose or suggest detecting a reproduction status of a plurality of content data items *when each content data item is reproduced*. Rather, Kajiyama discloses a storage medium playback method which includes a detection of a reproduction status based on pre-recorded reproduction management information (§[0045]). Specifically, the method disclosed by Kajiyama allows data stored in different storage areas on a recording medium (e.g., video and audio) to employ this pre-recorded reproduction management information to be played back in a synchronized manner, so that, for example, a user of a personal computer may play back a digital video disk (DVD) or enhanced compact disk (CD) (§[0008]-[0010]).

Kajiyama also fails to disclose or suggest selecting a *recommendation content data item* depending on a reproduction status. Kajiyama simply says nothing at all regarding any content data item being a recommendation content data item.

Hori fails to remedy these deficiencies of Kajiyama. Hori says nothing at all relating to detecting a reproduction status of a plurality of content data items when each content data item is reproduced, or selecting a recommendation content data item depending on a reproduction status, as required by claim 1.

Accordingly, amended claim 1 patentably distinguishes over the prior art of record, such that the rejection of claim 1 under 35 U.S.C. §103(a) as purportedly being unpatentable over Kajiyama in view of Hori should be withdrawn.

Claims 2-6, 8, and 19-21 depend from claim 1 and are allowable for at least the same reasons.

B. Claim 9

As amended, claim 9 recites a data processing method for use with a data processing apparatus. The method comprises steps of, *inter alia*, detecting a reproduction status of each of a plurality of content data items when said each content data item is reproduced by a reproducing unit, selecting a recommendation content data item from said plurality of content data items depending on a reproduction status of said recommendation content data item, and transmitting a list which shows said selected recommendation content data item.

It should be clear from the discussion above relating to claim 1 that the asserted combination fails to disclose or suggest a data processing method which satisfies the limitations of claim 9. Accordingly, claim 9 patentably distinguishes over the asserted combination, such that the rejection of claim 9 under 35 U.S.C. §103(a) should be withdrawn.

Claims 22-30 depend from claim 9 and are allowable for at least the same reasons.

C. Claim 10

As amended herein, claim 10 recites at least one computer-readable medium having instructions encoded thereon which, when executed by a data processing apparatus, perform a method substantially similar to the method of claim 9. For the reasons discussed above with reference to claim 9, claim 10 patentably distinguishes over the asserted combination, such that the rejection of claim 10 under 35 U.S.C. §103(a) should be withdrawn.

Claims 31-39 depend from claim 10 and are allowable for at least the same reasons.

D. Claim 18

As amended herein, claim 18 recites a data processing system having a first data processing apparatus and a second data processing apparatus. The first data processing apparatus comprises, *inter alia*, a first control unit configured to detect a reproduction status of each of a plurality of content data items when said each content data item is reproduced by a reproducing unit, and to select a recommendation content data item from said plurality of content data items depending on a reproduction status of said recommendation content data item. The first data processing apparatus further comprises a first communication unit configured to transmit to the second data processing apparatus a first list which shows the selected recommendation content data item.

It should be clear from the discussion above with reference to claim 1 that the asserted combination of Kajiyama and Hori fails to disclose or suggest a data processing system which satisfies the limitations of amended claim 18. Accordingly, claim 18 patentably distinguishes over the asserted combination, such that the rejection of claim 18 under 35 U.S.C. §103(a) as purportedly being unpatentable over Kajiyama in view of Hori should be withdrawn.

CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the application in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

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Respectfully submitted,

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